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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,784	09/01/2000	Franciscus Cornelis Caris	US 000220	5607

7590

06/01/2004

U S Philips Corporation  
580 White Plains Road  
Tarrytown, NY 10591

EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

14

# Office Action Summary

Application No.

09/653,784

Applicant(s)

CARIS ET AL.

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4-6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

1. This communication is in response to Application No. 09/653,784 filed 03/08/04, claims 1, 3-13, and 15-17 have been amended and claim 18 has been added. Claims 1-18 remain pending and have been examined.
2. Acknowledge is made to claim to co-pending application No. 09/519,546 filed 03/06/00.
3. Correction to Drawings have been received and accepted by Examiner.
4. Corrections to the claims to correct noted informalities are noted.
5. Regarding added limitation, "the server having an associated customer base comprising a plurality of user profiles, each profile comprising a list of one item of consumer electronic equipment for the consumer". Certain uncertainties are raised with respect to the claims as amended, for example a list is understood to be at the least two or more items, it is not quite clear how the profile comprises one item, yet it is still a "list". Are the "consumer electronics equipment" different than "the first appliance", or different entities? Each profile, according to the claim comprises a list of one item of the consumer electronic equipment for the consumer, yet the server selects a user profile for the downloading of code according to a user profile that is associated with the remote control (are these user profiles different from one from the other?). All claim(s) limitations will be treated (see MPEP 2143.03). Broadest reasonable interpretation to the claim language will be applied (see MPEP 2111). In this case, the claim will in substance read, a host (server or source) having storage means ("customer base") with information associated with a plurality of users ("user profiles"), each profile comprising an item of (related to or about) a remote control device associated with a first appliance.

***Claim Rejection 35 U.S.C. §103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allport U.S. Patent No. 6,104,334 in view of Goldstein U.S. Patent No. 5,410,326.

Regarding claim 1, Allport teaches substantial features of the invention as claimed, teaching a system/method and software implementation (col 7/lines 49-52) including a programmable remote control for controlling various appliance (abstract), wherein the appliances are Internet connectable (col 9/lines 63-65), the method comprising,

enabling connecting the appliance to a server on the Internet in response to the consumer controlling the remote control device (Allport: actuating buttons on a remote control for downloading data into the remote control from a source (i.e. connected) on the Internet using a third party e.g. a PC ("appliance"), col 8/lines 30-57, or using another device display e.g. web browser ("appliance"), col 9/lines 63-65, access to web sites (i.e. connects) using the remote control, col 4/lines 62-65); and

enabling the server to download to the appliance data representative of a control code for being programmed into the remote control device via the appliance (Allport: downloading device configuration data or libraries see col 5/lines 50-67, downloading into remote control see col 4/lines 52-57, gather programmable data see col 5/lines 50-67, download via third party appliance see col 8/lines 30-53); however Allport does not explicitly teach storing user information ("user profiles") for each user regarding the appliances for the user wishes to obtain, wherein said user information is stored on a storage means ("customer base");

Goldstein teaches a server providing services to a plurality of subscribers for obtaining codes for programming a remote control for operating various appliance via the remote control, each users who has subscribed to receive codes for operating appliance via a service subscription will be transferred said codes according to the their subscription ("stored user profiles") (col 16/lines 21-32), from a plurality of codes available on the server (col 15/lines 20-31).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the teachings of Allport for configuring a programmable remote control for controlling various appliance and his suggestion for obtaining the code for programming the remote control from Internet service providers (ISPs), that access mechanisms such as subscriptions service would be inherent and obvious, thereby readily apparent to one ordinary skilled. Hence, the teachings of Goldstein where the user subscribes to a service provider having all codes for operating appliances manufactured by various manufactures for configuring a remote control, and where the service provider downloads all and only

the services the user has subscribed to, thereby maintaining (storing in a storage means, e.g. database) ("customer base") user information ("user profiles") for each subscribing user ("user profile") regarding the services to be provided to each of the subscribers is readily apparent, user information further including the appliances (list) for the user wishes to obtain (i.e. has subscribed to) either through the initial subscription process, registration process or learned overtime would have been obvious to an artisan in the art given the teachings of the reference. Motivation to combine the teachings of Goldstein and Allport would be enable the user to added or update his/her initial subscription including the appliance the user wishes to obtain programming code from the pool of the compiled database of available codes for operating appliance manufactured by various manufactures enabling the user to select latest advances in technology offered by retailers.

Regarding claim 2, enabling the consumer to manipulate the data prior to the data being programmed into the remote control device (Allport: scroll or select, i.e. "manipulate" data see col 15/lines 5-26, user selects and then download see col 8/lines 30-57, scroll through sources see col 14/lines 17-20, via remote controller or third party appliance display see prior to downloading col 8/lines 30-46).

Regarding claim 3, enabling to program the remote control device via a wireless connection between the appliance and the remote control device (Allport: programming a remote control, where the appliance and remote control communicate via an infrared (IR) connection see col 5/lines 66-col 6/line 13, wireless, or CEBus connection i.e. a networking electronic consumer standard which includes e.g. infrared light see col 4/lines 36-39).

Regarding claim 4, enabling the consumer to notify the server, through the first appliance of equipment for which to download the control code (Allport: download upon request, request including user selected data to be downloaded "informing" to source what data to download see col 15/lines 5-26, data such as control code of wide variety such as configuration information or command libraries to be downloaded for controlling different devices, i.e. equipments where the server is contacted via a third party appliance see col 5/lines 5-67).

Regarding claim 5, the equipment comprises a further ('second') appliance (Allport: appliances see col 9/lines 21-28, devices to be controlled see col 9/lines 63-65).

Regarding claim 6, further including: the equipment comprises the ("second") appliance (Allport: devices to be controlled e.g. TV, CD see col 50-col 6/line 21, other devices to be controlled see col 4/lines 5-10); and

the control code relates to a functionality of the ("second") appliance (Allport: control code of wide variety such as configuration information or command libraries to be downloaded for controlling different devices, i.e. equipments see col 5/lines 5-67).

storing user information including consumer electronic equipment associated with a user (Goldstein: col 16/lines 21-32).

Regarding claim 7, comprises limitation substantially the same as those discussed with respect to claim 1, same rationale of rejection is applicable; the remote control device is programmable (Allport: abstract, col 44/lines 44-33) ;

the remote control device has a button (Allport: keyboard for programming see col 8/lines 30-57, including soft or hard buttons for user selections see col 10/lines 27-67, including for downloading software into the remote control see col 8/lines 30-57) for causing the third party appliance to connect to a server on the Internet supporting download of data therewith, (Allport: remote control controls an appliance e.g. browser-enabled TV see col 9/lines 63-65) and downloading programming information and storing into the remote control over an established connection to support receipt of data to be stored into the remote control's memory) (Allport: col 8/lines 30-57);

the ("Internet-connectable") appliance is capable of programming the remote control device based on data received from the ("specific") server via third party software on the appliance (e.g. web-enable TV or PC) (Allport: col 8/lines 30-57 and col 9/lines 63-65).

Regarding claim 8, wherein the ("Internet-connectable") appliance allows a user to manipulate the data prior to programming the remote control device (Allport: scroll or select, i.e. "manipulate" data see col 15/lines 5-26, select and then download see col 8/lines 30-57, scroll through sources of data see col 14/lines 17-20, via remote controller or third party display see col 8/lines 30-46).

Regarding claim 9, wherein the appliance and the remote control device communicate via a wireless connection for programming (Allport: appliance-device wireless connection, col 5/lines 66-col 6/line 13, col 4/lines 36-39, and remote controlled programmed via third party appliance e.g. PC or web enabled TV col 8/lines 30-57 and col 9/lines 63-65).

Regarding claim 10, wherein the appliance comprises a set top box (Allport: devices to controlled include cable box coupled to TV, col 8/lines 58-67).

Regarding claim 11, comprises claim limitations substantially the same as claim 1, thereby same rationale of rejection is applicable, limitation further include

enabling a user of ("CE") equipment to specify to a server on a data network information about the equipment (Allport: user sending a request for data for programming data on an equipment to a server for downloading requested data see col 8/lines 30-53, information selectable and specific to an equipment see col 5/lines 50-65); user of a plurality of user providing information regarding the customer electronic equipment forming his/her profile (Goldstein; col 16/lines 21-32 and col 15/lines 20-31).

enabling to program via the data network remote user control of the equipment according to the information (Allport: configuration information and libraries to program remote controller for controlling devices via a data network e.g. the Internet see col 5/lines 50-65) and

storing the information in the customer base (Allport: storing downloading information at the remote controller memory storage "customer base" see col 8/lines 52-57, remote controller having storage means see col 7/lines 56-60).

Regarding claim 12, supplying a remote control device that is pre-programmed for use with a set top box (Allport: prior art remote controller are pre-programmed for controlling appliances, see col 1/lines 38-45 for controlling appliances including cable boxes, see col 8/lines 58-67);

the method is used for subsidizing the set top box (Allport: method is an improvement or aid i.e. subsidize over the prior art, see col 3/lines 52-60).

Regarding claim 13, comprising supplying the remote control device (Allport: Fig. 2, col 9/lines 6-9).

Regarding claim 14, enabling to use the storage ("customer base") to provide a user-selectable ("customized") service to the user (Allport: user-selectable configuration col 5/lines 50-65 for controlling a plurality of devices by storing downloaded configurable programs col 8/lines 52-57 and col 7/lines 56-60).

Regarding claim 16, the limitations of this claim are substantially the same as the limitation of claim 1, same rationale of rejection is applicable.

Regarding claim 17, comprises features discussed on claim 1, same rationale of rejection is applicable, and further limitations include

a look-up table that is programmable with data downloaded from a server on the Internet (Allport: a data structure or memory structure ("lookup table") that is programmable or loadable with programs downloaded from a server on the Internet, see col 8/lines 30-57, remote control with storage capabilities, see col 7/lines 56-60, data downloaded for programming remote control, see col 5/lines 50-67);

the look-up table maps a first control code, received from a remote control device, onto a second control code for control of an apparatus via the appliance (Allport: downloadable programs are specific to each the appliance from the plurality of appliances the remote control is to control, therefore the programs (i.e. "control codes") each correlated ("are mapped") to a specific apparatus to be controlled, see col 8/lines 50-66, wherein received at the remote control device via an appliance having a third part software, e.g. PC or web browser, col 9/lines 58-65, col 8/lines 30-40 or e.g. to control a TV apparatus via a web browser appliance).

8. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et. al. U.S. Patent No. 6,578,142 (Anderson hereafter) in view of Allport U.S. Patent No. 6,104,334.

Regarding claim 15, Anderson teaches substantial features of the invention as claimed, teaching a method/apparatus of providing customized service to user of ("consumer electronics") equipment (Anderson: col 3/lines 10-30, col 2/lines 26-33, 36-37);

a profile based on the user having specified to a server on a data network, information about the equipment (Anderson: col 5/lines 11-38 and col 8/lines 53-58);

each profile comprising equipment items (col 5/lines 11-38 and col 3/lines 19-30);

downloading via the data network code to program equipment (Anderson: col 5/lines 11-38 and col 3/lines 19-30, 49-54, col 4/lines 46-56);

storing the information about the equipment in a data base comprising a plurality of profiles (Anderson: col 5/lines 11-38 and col 4/lines 38-45);

each profile comprising one demographic and equipment information (Anderson: col 8/lines 52-63); however Anderson does not explicitly teach programming a remote control for controlling equipment

Allport teaches programming via the data network a remote control used for controlling a plurality of appliances, including: downloading program over a data network e.g. the Internet to the remote control's memory (see col 8/lines 3-57), downloaded program to configure the remote control to control a plurality of appliances (see col 5/lines 50-67).



It would have been obvious to one ordinary skilled in the art at the time the invention was made given Anderson's teachings for providing a customized service using user profiles stored at a server and suggestions of applying the disclosure to any circuitry capable of processing data including electronic equipment used by consumers to implement Anderson's teachings to Allport's remote control device. Motivation to combine these teachings would be to enable the generation of user profiles by directly surveying the user via warranty service registrations or service provider registrations. The user may upon purchase of hardware and/or software equipment, products of various manufactures, electronic devices and/or communication equipment may registers these items generating by the server or service center, a user and system profiles including a list of user's electronic equipment and/or devices based on which customized services are provided to the user, such as service and products available related to the user's existing system or those that may be of interest to the user which may further be based on an created aggregated user profile model.

Regarding claim 18, a data base comprising the compilation of user profiles, each profile comprising a series of equipments or products associated with the consumer uploaded to a server or service center (Anderson; col 5/lines 11-38 and col 9/lines 39-61);

each profile comprising equipment items or products (col 5/lines 11-38 and col 3/lines 19-30);

communication to the server is via an internet appliance associated with the user's remote control device (Allport: col 15/lines 5-26, col 5/lines 5-67 , 8/lines 30-57, col 9/lines 63-65, col 4/lines 62-65).

**Citation of Pertinent Art:**

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,933,811

Angles teaches features of claim 1, including a service provider having a customer base including user profiles comprising items for the consumer and demographic information associated with the consumer.

Specifically, a service provider which stores demographic information about consumers in a demographic database, and sends information (e.g. customized advertisements) to the consumers based on the consumers demographic profile and a consumer history (i.e. tracks consumer responses to the customized

U.S. Patent No. 5,794,210

Goldhaber et. al. teaches features of claim 11, including enabling a plurality of users to specify to a serving host information related to them selves using said information for creating a plurality of user profiles.

Specifically, teaching wherein information provided by the consumer is stored in a database 120. Wherein at registration time, the consumer may be asked to provide information useful in forming interest profile 124, e.g. filling "profile questionnaire" and associated information requesting certain demographic related information from the consumer.

*Response to arguments*

9. Regarding claims 1-17, it is argued Allport does not teach the limitation added to the claims, this is according to applicant a customer base comprising a plurality of user profiles, each user profile may comprise a list of the user's consumer electronics equipment.

In response to the above mentioned argument, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., each user profile may comprise a list of the user's consumer electronics equipment) are not recited in the rejected claim(s). This is no suggestion of any sort. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim recites, a customer base comprising a plurality of user profiles, each profile comprising a list of *one item of consumer electronic equipment* for the consumer; *not a list of consumer electronics equipment*, as argued.

It is noted that the added subject matter upon which applicant relies on as patentably distinguishable, has been thoroughly considered, the above mentioned prior art as well as prior art made of record but not relied on in substance discloses user profiles, setting or preferences associated with subscription services environments upon which user and/or system information is either generated upon demand or automatically and aggregated or compiled into a profile or model that is use for customizing, personalizing and targeting services, this as shown by the references is known in the art. A service provider (i.e. "server") having information about the user ("customer base comprising profiles including list of consumer electronic equipment of the consumer") based on which services and products are provided to the user is well known in the art.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Prosecution of this application is closed by means of this final office action § 1.113, applicant may request continued examination of the application by filing a Request for Continued Examination of under 37 CFR § 1.114 and providing the corresponding fee set forth in § 1.17(e) for the submission of, but not limited to, new arguments, an information disclosure statement, an amendment to the written description, claims, drawings, or new evidence in support of patentability. Or applicant whose claims have been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences under 35 U.S.C. §134.

12. Applicant is reminded of 37 CFR 1.530 (e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there **MUST** also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper (see MPEP 2234). There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96; however, with respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims. See MPEP § 714.02, and 2163.06. ("Applicant should specifically point out the support for any amendments made to the disclosure.") (see MPEP § 2163.04).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this final action should be mailed to:

**Box AF**

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or faxed to the Central Fax Office:  
(703) 872-9306, for Official communications and entry

Or Telephone:  
(703) 306-5631 for TC 2100 Customer Service Office

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

  
JACK B. HARVEY  
SUPERVISORY PATENT EXAMINER

B. Prieto  
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Patent Examiner  
May 20, 2004